

REMARKS

In the Office Action of September 10, 2003, Claims 51-53, 60, 61,64,66,69, and 71 are rejected as anticipated. Claims 72 and 73 are indicated as allowed, and Claims 54, 55, 62, 63, 65, 67, 68 and 70 are objected as being dependent from a base claim. Claims 51-55 and 60 are amended, and Claims 61 and 62 are cancelled. Claims 51-55, 60, 63-73 are pending.

Applicant disagrees with the Examiner's ground of rejection, but in order to further prosecution of the claims indicated as allowable, Claim 60 has been amended to include the language of Claim 62 to place Claims 60, 63-71 in condition for allowance, with the understanding that the amendment is made without prejudice to Applicant's ability to file a continuation application with respect to any of the cancelled or amended claims.

Additionally, independent Claim 51 has been amended to incorporate the "wherein" language of Claim 55, but without the language of intermediate Claim 52 from which Claim 55 depended prior to amendment (note Claim 52 previously depended from Claim 50, a cancelled claim). The examiner is respectfully requested to consider the patentability of Claim 51, as amended to recite at least one radiopaque marker element, and without the recitation of the original language of Claim 52).

Also, dependent Claim 52 is amended to depend from Claim 51 and to incorporate language found in Claim 70. Dependent Claim 53 is amended to depend from Claim 51 and to include language found in Claim 71. Dependent Claim 54 is amended to depend from Claim 51 and to incorporate language found in Claim 67, and Dependent Claim 55 is amended to depend from Claim 51 and incorporate language founding Claim 68.


Supplemental IDS:

The Examiner is requested to consider and make of record the information disclosure statement submitted May 1, 2003, and resubmitted with this response.

Conclusion:

The Examiner is respectfully urged to reconsider and allow the pending claims.

Respectfully,


Gerry Gressel, Reg. 34,342

Feb 10, 2004

Johnson & Johnson
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,125	02/02/2001	Seth A. Fourstar	END-723	1306

7590 09/10/2003

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EXAMINER

BAXTER, JESSICA R

ART UNIT

PAPER NUMBER

3731

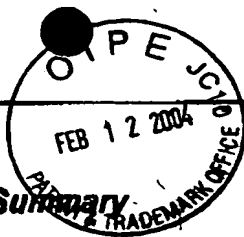
J&J PAT. DKT. SECTION

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Response due
12/10/03

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Office Action Summary

Application No.

09/776,125

Applicant(s)

FOERSTER ET AL

Examiner

Jessica R Baxter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003 and 13 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.O. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-55 and 60-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 13 is/are allowed.
- 6) ☒ Claim(s) 51-53, 60, 61, 64, 66, 69 and 71 is/are rejected.
- 7) ☒ Claim(s) 54, 55, 62, 63, 65, 67, 68 and 70 is/are objected to.
- 8) ☒ Claim(s) 51-55 and 60-73 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.65(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of.
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on May 6, 2003 has not been considered since neither a list or copies of the references were in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 51-53, 60, 61, 64, 66, 69 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,900,304 to Fujioka et al.

Fujioka discloses a marker instrument comprising a tube comprising a lumen (FIG. 5 and 6); an axial opening at a proximal end of said tube; a closed tip at a distal end of said tube (Column 5 lines 25-35); a side exit port proximal to said closed tip; and a plurality of marker elements disposed in said lumen (Column 3 lines 64-66).

Fujioka discloses a tube comprising a lumen (member 3); and a side exit port communicating with said lumen (recess 1b); a plurality of tissue markers disposed in said lumen (Column 3 lines 64-66) proximal of said side exit port; and an element slidably disposed in said lumen (FIG. 4(b) portion 1d).

Allowable Subject Matter

4. Claims 54, 55, 62, 63, 65, 67, 68 and 70 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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5. Claims 72 and 73 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 51-55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Jessica R Baxter
Examiner
Art Unit 3731

jr
September 8, 2003

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked-up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained:

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, must include a complete listing of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show **current changes**) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **previously presented** and **(not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer**, double brackets may be used (e.g., **Herewith**); and (2) if **strikethrough cannot be easily perceived** (e.g., deletion of the number "4" or certain punctuation marks), **double brackets must be used** (e.g., **11411**). **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change** (e.g., **number 1 as number 14 us7**). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.